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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/017,394

12/18/2001

Kazuhiro Hayashi

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65565 7590 11/10/2008

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT

PAPER NUMBER

2445

MAIL DATE

DELIVERY MODE

11/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/017,394	Applicant(s) HAYASHI ET AL.	
	Examiner Jeffrey R. Swearingen	Art Unit 2445	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 29-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20081028</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2445

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/28/2008 has been entered.

Response to Arguments

2. Applicant's arguments filed 10/28/2008 have been fully considered but they are not persuasive.

3. Applicant argues that a karaoke system as taught in Tsai is not portable. Figure 2 of Tsai shows that Tsai is a physical karaoke system, with physical parts. One of ordinary skill would know that during operation, a physical karaoke system could be moved a couple of inches in order for the person with the microphone to be able to not pull the microphone out of the jack. Portable only means that the object can be moved.

4. Applicant argues that Tsai fails to disclose an updating system which updates the number of plays each time the reproduction of music is complete. Reproduction does not necessarily mean playing back the music. Reproduction also can include downloading or "reproducing" the music over the Internet, as in Tsai. Downloading a file involves copying the file from a remote location to a local location. Copying is reproducing, *ergo* downloading is reproducing. Tsai does not have to even start playback in order to "reproduce" the music; all Tsai must do to meet the claim language is download the music.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Art Unit: 2445

6. Claims 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsai (U.S. Patent No. 6,572,381).

7. In regard to claims 29-31 (all claims have equivalent subject matter), Tsai disclosed:

a storage section which stores data of pieces of music that a user possesses, and is adapted to store a number of plays of each of said pieces of music, column 8, lines 46-61

a reproducing section which reproduces said data of pieces of music, column 8, lines 46-61

a transfer section that transfers the data, and column 8, lines 46-61

a portable terminal adapted to reproduce the music while disconnected from the server apparatus, the portable terminal capable of being carried for reproducing said data of pieces of music by a user, comprising column 8, lines 46-61

an interface that receives the data transferred from the transfer section, column 8, lines 50-54

a terminal-side storage section that stores data received through the interface, and column 8, lines 46-61

an updating section that updates a number of plays of each piece of music that is reproduced, each time said reproducing is completed at the portable terminal, and that stores the updated number of plays of each of said pieces of music in the terminal-side storage section; column 22, lines 45-56

wherein, if the portable terminal is connected to the server apparatus through the interface, the updated number of plays of each of said pieces of music stored in the terminal-side storage section are sent to the server apparatus, and the server apparatus updates the number of plays of each of said pieces of music stored in the storage section in accordance with the updated number of plays of each of said pieces of music stored in the terminal-side storage section. Column 22, lines 45-67

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2445

9. Bartholomew US 7,069,310

10. This is a request for continued examination of applicant's Application. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571)272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2445

Jeffrey R. Swearingen
Examiner
Art Unit 2445

/J. R. S./
Examiner, Art Unit 2445

/Jason D Cardone/
Supervisory Patent Examiner, Art Unit 2445